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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,687	09/08/2003	Salvatore Rea	2002L007A	1241
7590 Infineum USA L.P. Law Department 1900 East Linden Avenue P. O. Box 710 Linden, NJ 07036-0710			EXAMINER NERANGIS, VICKIE MARIE	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 06/29/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**After the Filing of an Appeal Brief**

Application No.

10/657,687

Examiner

VICKEY NERANGIS

Applicant(s)

REA ET AL.

Art Unit

1796

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

The reply filed 6/22/09 is acknowledged.

1. ☒ The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

a. ☐ The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

b. ☒ The affidavit or other evidence is not timely filed before the filing of an appeal brief.  
See 37 CFR 41.33(d)(2).

2. ☐ The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. ☐ The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. ☒ Other: It is first noted that the nonstatutory obviousness-type double patenting rejection over US 6,642,188 has been withdrawn. Furthermore, as set forth in the Examiner's Answer, the data in the affidavit filed on 4/2/09 is not reasonably commensurate in scope with the scope of the claims for two reasons. First, the examples only include blends of ethoxylated C4-C18 alkyl phenol having 2-10 moles of ethylene oxide per mole (rust inhibitor (i)) and C8-C22 alkyl or alkenyl succinic acid or anhydride (rust inhibitor (iv)) and not rust inhibitors (ii) or (iii) like presently claimed. Second, only a 50:50 blend is exemplified, wherein it has not been established if the unexpected result with rust inhibitor (iv) is also present when mixed in ratios not 50:50 such as 95:5 or 25:75. Case law holds that evidence is insufficient to rebut a prima facie case if not commensurate in scope with the claimed invention. In re Grasselli, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Given that entry of an affidavit after filing of an Appeal Brief requires both that it overcomes all rejections of record and good and that sufficient reasons why the affidavit was not earlier presented must be had, the affidavit is not entered on the basis that it does not overcome all rejections of record despite a basis for the latter

/Vickey Nerangis/  
Examiner, Art Unit 1796